

which is accessible at www.e-freestuff.com and can be accessed by entering user name

“efsdemo2” and password “efs02”.

2. The Examiner has indicated that the drawings are informal but acceptable for examination purposes. Accordingly, Applicants will provide formal drawings upon indication of allowability.

3. Claims 3, 4, 5, 9, 23, 24, 25, 29, 41, 42, 43 and 47 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because applicants recite a time period of “no less than about 5 seconds” without reciting an upper limit.

Applicants respectfully submit that these claims, as presently drafted, are definite, and do particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully submit that there is simply no requirement, under the rules or the case law, to add an upper limit in this regard. In fact, Applicants note that there are a large number of issued patents which recite only a lower limit, without an upper limit, for various claim limitations.

Accordingly, withdrawal of this rejection is respectfully requested.

4. Claims 1-77 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,791,991 to Small (“Small”) because the Examiner states that Small “shows elements that suggest the elements and limitations” of the claims. As to Claims 4-21, 24-40, 42-59, 62-72, and 75-77 the Examiner further states “official notice is taken that both the concepts and the advantages of the elements and limitations of the claims were well known and expected in the art at the time of the invention.”

Applicants respectfully traverse the rejection and submit that a prima facie case of obviousness has not been made and that Claims 1-77 would not have been obvious over Small because Small does not teach or suggest the following limitations, nor were they well known and expected in the art at the time of the invention:

- a minimum initial advertisement viewing period before being able to submit an entry to win a prize as claimed in Claims 1-77;
- a limitation on the period of time during which the viewer may submit and entry to win a prize as claimed in Claims 3, 23, and 41 and the claims that depend therefrom;
- interstitial or dynamic interstitial advertisements as claimed in Claims 21, 40, 59, and 73 and the claims that depend therefrom; and
- displaying individual advertisements to a viewer in series as claimed in Claims 23, 62 and 75 and the claims that depend therefrom.

5. Applicants respectfully submit that Claims 1-77 are not obvious in view of Small because Small does not teach or suggest the use of a time delay before offering the viewer an opportunity to submit an entry to win a prize.

Claims 1-77 of Applicants' invention claim a system and method of advertising wherein a user is provided with opportunity to win a prize only after the user has viewed an advertisement for some minimum period of time. In this way, the user cannot simply click through the ad and receive the reward without having actually viewed the advertisement at all or for a sufficient

period of time. This aspect of the invention is critical to the effectiveness of the advertisement on the viewer.

Small is silent as to the linking of the viewing of advertisements with an opportunity to win a prize and in particular to providing an opportunity to win a prize only after the viewer has watched the advertisement for some minimum period of time.

The Small reference discloses the use of games of chance, such as keno or bingo, as a means for distributing cash rewards, coupons or rebates. In the Small disclosure, the traditional bingo or keno game board has product categories associated with each square instead of numbers. Small modifies the traditional bingo or keno by hiding the product categories (the equivalent of the numbers in the traditional game) assigned to each square of the board and allowing the player to select product categories from a list (the equivalent of pull the numbered balls from a bin in the traditional game). The selected product categories are then matched to the hidden product categories on the board. Depending on the pattern formed by the matches on the board the player may win cash, coupons or rebates. In one embodiment, the Small reference discloses that the product categories in the game board squares may be hidden by ads or logos. However, this aspect is collateral to the game play and the function of distributing coupons and rebates. Small does not teach or disclose any relationship between the viewing of these ads or logos and the ability to win a prize. In particular, Small does not teach or suggest the imposition of any restriction of game play based on the period of time the ads or logos are displayed.

Applicant also calls to the Examiner's attention the International Preliminary Examination Report (IPER) from the corresponding PCT application. The IPER found claims 1-

77 of Applicants' invention to be novel, have inventive step and have industrial applicability over Small at least because the claims provided "[a] system of advertising to a viewer wherein by viewing an advertisement of an advertiser a viewer may qualify to win a prize, comprising ... transmitting to the view[sic] an offer to submit an entry to win a prize in response to the advertisement wherein the viewer is offered the opportunity to submit the entry only after the advertisement has been displayed to the viewer for a period of time..." (emphasis added).

Accordingly, Applicants respectfully submit that the Small patent does not teach or suggest the Applicants' claimed invention. Since the reference cited does not teach or suggest what the Applicants claim in Claims 1-77, a prima facie case of obviousness has not been made. Withdrawal of the rejections is respectfully requested.

6. Applicants respectfully submit that Claims 3, 23 and 41 are not obvious in view of Small because Small does not teach or suggest the use of a limitation on the period of time during which the viewer may submit an entry to win a prize.

Claims 3, 23 and 41 of Applicants' invention limit the period of time during which a viewer has the opportunity to submit an entry to win a prize. By this means, the viewer must remain alert and pay attention to the advertisement so as not to miss the opportunity. The limitation on time is critical to the effectiveness of the advertisement because the viewer must remain focused on the ad. If the viewer looks away he may miss the limited opportunity to submit an entry for the prize.

The Small reference is silent as to any time restrictions on its keno or bingo game, and there are no other functions suggested or disclosed that serve to require the player to pay attention to any ads or logos on the game board.

Accordingly, Applicants respectfully submit that the Small patent does not teach or suggest this further limitation of Claims 3, 23 and 41. Since the reference cited does not teach or suggest this further limitation claimed in Claims 3, 23 and 41, a prima facie case of obviousness has not been made. Withdrawal of the rejections and allowance of Claims 3, 23 and 41 is respectfully requested. Claims 4-21, 24-40, 42-59, and 76-77 depend from and further limit Claims 3, 23 or 41 and are thus also believed to be allowable.

7. Applicants respectfully submit that Claims 21, 40, 59 and 73 are not obvious in view of Small because Small does not teach or suggest using interstitial or dynamic interstitial advertisements.

Claims 21, 40, 59 and 73 of Applicants' invention claim interstitial or dynamic interstitial advertisements, which are full screen or full browser window advertisements. The use of full screen or full browser window advertisements focuses the viewer's attention on the ad and removes the opportunity for the viewer to be distracted by other on screen material. The dynamic aspect of the interstitial ad of the present invention makes the ad more appealing and entertaining to the viewer. Each of these aspects are again critical to the effectiveness of the ad.

The Small reference is silent as to the use of either static or dynamic interstitial advertisements. Although the Small reference discloses the use of ads or logos to block the squares of the game board matrix, Figs. 3-6 teach away from the display of interstitial

advertisements in that ads are restricted to relatively small squares and the screen display area is used for other game play functions preventing full screen ads.

Accordingly, Applicants respectfully submit that the Small patent does not teach or suggest this further limitation of Claims 21, 40, 59 and 73. Since the reference cited does not teach or suggest these further limitations, a prima facie case of obviousness has not been made. Withdrawal of the rejections and allowance of Claims 21, 40, 59 and 73 is respectfully requested. Claims 76 and 77 depend from and further limit Claims 21, 40, 59 or 73 and are thus also believed to be allowable.

8. Applicants respectfully submit that Claims 23, 62 and 75 are not obvious in view of Small because Small does not teach or suggest the serial display of advertisement to a viewer.

Claims 23, 62 and 75 of Applicants' invention claim the display of advertisements to the viewer in series. The serial display of advertisements permits the viewer to watch advertisements one after another. The serial display makes the viewing process easy for the viewer and is thus likely to keep the viewer interested for longer uninterrupted periods.

The Small reference only discloses the use of ads or logos to block the squares of the game board matrix and is silent as to serial display. The Small reference teaches the simultaneous display of numerous ads/logos in the game board matrix but does not suggest the serial display claimed in Applicants' invention.

Accordingly, Applicants respectfully submit that the Small patent does not teach or suggest this further limitation of Claims 23, 62 and 75. Since the reference cited does not teach or suggest this further limitation, a prima facie case of obviousness has not been made.

Withdrawal of the rejections and allowance of the claims is respectfully requested. Claims 24-40, 76 and 77 depend from and further limit Claims 23, 62 or 75 and are thus also believed to be allowable.

9. As discussed above, Applicants contend that since Small does not teach or suggest what the Applicants claim, a prima facie case of obviousness has not been made. Accordingly, reconsideration and withdrawal of the rejections under §103(a) is respectfully requested.

CONCLUSION

Based on the foregoing remarks, it is respectfully submitted that the claims are patentable and in condition for allowance.

If any issues remain, or if the Examiner has any suggestions for expediting allowance of this application, he is respectfully requested to contact the undersigned at the telephone number listed below.

Favorable consideration is respectfully requested.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4022-4001US1. **A DUPLICATE OF THIS DOCUMENT IS ATTACHED.**

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

Dated: January 9, 2003

By: 

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